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IN THE

# SUPREME COURT OF THE UNITED STATES

**OCTOBER TERM, 1966**

No. ~~1966~~ 178

MITCHELL FOODS, INC. and FRANK S. MITCHELL,
*Petitioners,*

*vs.*

RICH PRODUCTS CORPORATION,
*Respondent.*

## PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

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## PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

Petitioners pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Second Circuit entered in the above-entitled case on February 15, 1966.

### CITATIONS TO OPINIONS BELOW

The opinion of the Court of Appeals is reported at 357 F. 2d 176 and is reprinted in the Appendix hereto (pp. 1a-11a). The findings of the District Court are reported at 246 F. Supp. 392 and are printed in the Appendix hereto (pp. 14a-21a).

### JURISDICTION

The judgment of the Court of Appeals was entered February 15, 1966 (Appendix, p. 12a). A petition for rehearing in banc was denied on April 11, 1966 (Appendix, p. 13a). The jurisdiction of this Court is invoked under 28 U. S. C. § 1254(1).

## QUESTIONS PRESENTED

**Question 1:**

Is the standard of non-obviousness for patentability under 35 U. S. C. § 103, as set forth by this Court in *Graham* v. *John Deere Co.*, 383 U. S. 1 and *United States* v. *Adams*, 383 U. S. 39, in conflict with that applied by the Court of Appeals for the Second Circuit in *Lyon* v. *Bausch & Lomb Optical Co.*, 224 F. 2d 530 (2 Cir. 1955) and *Reiner* v. *I. Leon Co.*, 285 F. 2d 501 (2 Cir. 1960)?*

**Question 2:**

Was it obvious, and therefore unpatentable under 35 U. S. C. § 103, in December, 1954 to improve the whippability of a whipped cream substitute described in a 1943 British patent by merely substituting one or more of a large family of newer food emulsifying agents for the older vegetable gum emulsifying agent of the prior British patent, and especially when some of the emulsifying agents claimed in the patent had been described in a prior publication for improving the whippability of natural cream?

## STATUTE INVOLVED

The provisions of Section 103 of the 1952 Patent Act (35 U. S. C. § 103) are as follows:

> "Conditions for patentability; non-obvious subject matter
>
> A patent may not be obtained though the invention is not identically disclosed or described as set

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* This case was decided by the Court of Appeals just six days before the decisions of this Court in *Graham* and *Adams*. The Court of Appeals based its decision squarely on *Lyon* and *Reiner*. In our petition for rehearing, we called the Court of Appeals' attention to the conflict between its earlier decisions in *Lyon* and *Reiner* with *Graham* and *Adams*. Yet the Court of Appeals in denying our petition for rehearing stated: "We have considered the case in the light of (1) *Graham* v. *John Deere Co.*, 383 U. S. —, 34 U. S. L. W. 4119 (1966) and (2) *United States* v. *Adams*, 383 U. S. —, 34 U. S. L. W. 4132 (1966), and are of the opinion that they do not require a change of holding."

forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

## STATEMENT OF THE CASE

Petitioners were sued in the Western District of New York by respondent for infringement of Diamond and Powell patent No. 2,868,653, applied for on December 3, 1954 and issued on January 13, 1959. Original jurisdiction under 28 U. S. C. § 1338(a) is not disputed.

The following essential facts are undisputed in the record.

The patent (PE 3-5)* describes and claims fat and water emulsions that can be whipped into a firm, non-pourable product useful as a substitute for whipped cream.

The five patent claims (PE 5) each define a product containing four essential ingredients of the whippable emulsion. The patent states that sweeteners, flavoring substances, salt, etc. are normally included in the product, but they are not required by the claims.

The four essential ingredients of the claims are (Finding 3, Appendix, p. 14a):

(1) water

(2) glyceride fat (oil)

(3) a special kind of substituted cellulose (methyl cellulose or methyl ethyl cellulose)

(4) one or more of a large group of synthetic emulsifying agents.

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* The printed testimony and exhibit appendices of petitioners in the certified transcript are referred to herein as DA and DE, and the printed appendices of respondent as PA and PE, respectively, followed by the page number in each instance.

The five claims of the patent differ from each other only in their specification of ingredient 4, the emulsifying agent. The emulsifying agents claimed are identified in the patent by their trade names, Spans, Tweens, Vrests, Myverols and Myrjs (Findings 4, 5, Appendix, p. 14a). Each trade name includes a substantial number of different compounds.

The same kind of non-protein, non-spoiling whippable cream substitute was taught by the 1943 British patent No. 555,361 (DE 99-103) as made with water, glyceride fat, methyl cellulose and a second emulsifying agent in the form of a vegetable gum stabilizer (DE 99, lines 11-57; DE 100, lines 52-62; DE 102, lines 70-77).

The sole novelty of the claims of the patent in suit over this British patent lies in the substitution for the vegetable gum emulsifying agent "A" of one or more of the large number of emulsifiers known as Spans, Tweens, Vrests, Myverols and Myrjs (Finding 9, Appendix, pp. 16a-17a).

The Spans, Tweens, Vrests, Myverols and Myrjs became available on the market as food emulsifiers some years after publication of the 1943 British patent (DA 244; Finding 9, Appendix, p. 17a).

Contrary to the Court of Appeals decision, the prior art publication by Pratt was not considered by the Patent Office (File history, DE 89). The Pratt article (DE 111-115) taught that by 1952 the claimed emulsifiers, Spans and Tweens, had been used in food products. Specifically, Pratt taught that these emulsifiers had been used in ice cream to make this kind of a fat and water emulsion stiffer as it came from the freezer, and that these claimed emulsifiers had been used also *to improve the whipping of cream.*

The trial court found

> (1) that the Pratt article disclosed the claimed emulsifiers but not in a whipped topping containing the substituted cellulose (Finding 11, Appendix, p. 18a), and

(2) that the claimed product was "of an inventive and patentable character" over these prior art citations (Finding 12, Appendix, p. 18a).

The Court of Appeals held the claimed subject matter as a whole was not obvious (Appendix, p. 8a), and that the formula of the patent in suit represented an advance that "was the result of something more than simply the skill and knowledge possessed by one familiar with the art" (Appendix, p. 9a). The Court of Appeals based its decision of non-obviousness on its 1955 decision in *Lyon* v. *Bausch & Lomb Optical Co.*, 224 F. 2d 530, 534-6, and its 1960 decision in *Reiner* v. *I. Leon Co.*, 285 F. 2d 501, 503-4 (Appendix, p. 9a).

The Court of Appeals opinion was filed February 15, 1966, six days before the opinions of this Court were rendered in *Graham* v. *John Deere Co.*, 383 U. S. 1, and *United States* v. *Adams*, 383 U. S. 39.

On Petition for Rehearing, petitioners pointed out:

(1) that the prior British patent taught the same kind of non-protein, non-spoiling whippable cream substitute made with fat, water and methyl cellulose, but with a vegetable gum emulsifier instead of the claimed Spans, Tweens, Vrests, Myverols and Myrjs;

(2) that the prior Pratt article (not before the Patent Office) taught that the claimed emulsifiers, Spans and Tweens, had been used in ice cream and natural cream packaged in pressurized containers to improve the whippability of those fat and water emulsion food products; and

(3) that contrary to Judge Hand's decisions in the *Bausch & Lomb* and *Reiner* cases, which were based on the theory that the 1952 Patent Act lowered the standard of patentability and was meant by Congress "to change the slow but steady drift of judicial decision that had been hostile to patents . . .", this Court has now stated in the *Graham* case (p. 17) that

> the 1952 Patent Act "was not intended by Congress to change the general level of patentable invention."

Nevertheless, the Court of Appeals, in response to this petition, stated they had considered the case in the light of this Court's opinion in the *Graham* and *Adams* cases "and are of the opinion that they do not require a change of holding." (Appendix, p. 13a).

It is recognized there is no simple formula for determining the answer to the question of obviousness in any given case. Also, we assume for purposes of this petition that substitution of one of the newer emulsifiers, Spans or Tweens, for the vegetable gum of the British patent produced substantial improvement in the whippability of the product.

But at the time of the alleged invention, Spans and Tweens were known to be good emulsifying agents and used in food products. The Pratt article specifically taught (PE 113, column 1):

> "Just as the whipping of the frozen dairy products is facilitated by the addition of emulsifiers, so also is the whipping of cream. In the now popular cream whip, distributed in pressurized vessels for home, fountain and restaurant use, certain emulsifiers have proved of value. Either polyoxyethylene (20) sorbitan monostearate or monooleate is suitable at a customary average level of 0.085%."

The specific emulsifiers mentioned are two of the Tweens claimed in the patent in suit.

Both the trial court and the Court of Appeals also ignored the testimony of respondent's expert, Dr. Oser, who admitted (DA 243-4) that the Spans and Tweens emulsifying agents of the Pratt article were "neutral", "available in food grade * * * in a safe wholesome form" and that it would be logical for anyone to try them out in a whipped cream substitute.

## ARGUMENT

The Court of Appeals decision on the issue of obviousness applied the lowered standard of patentability indicated by Judge Learned Hand in 1955 in *Lyon* v. *Bausch & Lomb Optical Co.*, 224 F. 2d 530, and again in 1960 in *Reiner* v. *I. Leon Co.*, 285 F. 2d 501. In *Bausch & Lomb*, Judge Hand said (p. 535):

> "On the other hand it must be owned that, had the case come up for decision within twenty, or perhaps, twenty-five, years before the Act of 1952 went into effect on January 1, 1953, it is almost certain that the claims would have been held invalid."

And in the *Reiner* case, Judge Hand said (p. 503) he considered the 1952 Patent Act was

> "meant to change the slow but steady drift of judicial decision that had been hostile to patents...."

The Court of Appeals judgment in this case was entered six days before this Court's decisions in *Graham* v. *John Deere Co.*, 383 U. S. 1 and *United States* v. *Adams*, 383 U. S. 39. The Court of Appeals denied a Petition for Rehearing, saying that they were of the opinion that the *Graham* and *Adams* decisions "do not require a change of holding".

The Court of Appeals decision is thus directly in conflict with this Court's latest decisions on the meaning and application of 35 U. S. C. § 103.

The decision of the Court of Appeals is also contrary to and in direct conflict with this Court's earlier decisions in *Sinclair Co.* v. *Interchemical Corp.*, 325 U. S. 327 (1945); *Dow Co.* v. *Halliburton Co.*, 324 U. S. 320 (1945) and *Mandel Bros.* v. *Wallace*, 335 U. S. 291 (1948) which this Court has now reaffirmed, and which compel a holding of "obvious" on the undisputed facts of the case at bar.

The trial court findings and the Court of Appeals decision emphasize the advantage of replacing protein with

methyl cellulose in a whipped cream substitute to give the product longer storage and shelf life. But a non-protein, non-spoiling, long-keeping whipped cream substitute made with methyl cellulose instead of the protein had been taught by the 1943 British patent (DE 99, line 52).

The sole question on obviousness is whether it was obvious in 1954 to try to improve the whipping properties of such a product by substituting for the vegetable gum emulsifier one of the whole host of new synthetic emulsifiers that had more recently become available on the market.

These new emulsifiers, according to respondent's own expert, were known to be acceptable in food products, neutral and bland in taste. These new emulsifiers were shown by the Pratt publication to improve the whipping properties of natural cream and to improve the whipping properties of ice cream, making the mix stiffer as it came out of the freezer. Nothing could have been more obvious than to try them out in a cream substitute to obtain the same advantage.

As this Court held in *Sinclair Co.* v. *Interchemical Corp.*, 325 U. S. 327, 335 (1945),

> "Reading a list and selecting a known compound to meet known requirements is no more ingenious than selecting the last piece to put into the last opening in a jigsaw puzzle."

The Court of Appeals opinion is also in direct conflict with this Court's earlier decisions in *Dow Co.* v. *Halliburton Co.*, 324 U. S. 320, 328 (1945) which said:

> "He who is merely the first to utilize the existing fund of public knowledge for new and obvious purposes must be satisfied with whatever fame, personal satisfaction or commercial success he may be able to achieve.";

and in *Mandel Bros.* v. *Wallace*, 335 U. S. 291, 295 (1948) where the Court said:

> "But we think that the state of the prior art was plainly sufficient to demonstrate to any skilled chemist searching for an anticorrosive agent that he should make the simple experiment that was made here. The patentees knew that urea was in general use as a stabilizing agent with acid and salts. Moreover, the patentees knew that standard alkalies had been successfully employed in prior patents for their anticorrosive effect. It is not surprising therefore that after experimenting with various standard alkalies in an effort to find a corrosion inhibitor that would not greatly reduce acidic astringency, the patentees promptly turned to urea. Their success was immediate."

The real vice of the Court of Appeals decision is that it removes from the public domain the use of all of the well-known commercial food emulsifiers, Spans, Tweens, Vrests, Myverols and Myrjs. Findings 7, 8 and 9 of the trial court state that superiority in whipping properties was demonstrated when *one of the Myverols,* Myverol 18-85, was used. The evidence and findings do not support a similar superiority in whippability for each, or any, of the others in the large family of emulsifying agents covered by the patent claims. None of the patent claims is specific to the particular emulsifying agent Myverol 18-85 on which the evidence of superiority is based. In fact, the specific emulsifier, Myverol 18-85, on which both the trial court and the Court of Appeals based their decisions, is not even mentioned in the patent in suit.

## CONCLUSION

Petitioners respectfully request that this petition for a writ of certiorari be granted.

Respectfully submitted,

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# APPENDIX

## OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

**Filed February 15, 1966**

ANDERSON, *Circuit Judge*:

This is a suit for infringement of claims one to four of United States Letters Patent No. 2,868,653, applied for on December 3, 1954 and issued on January 13, 1959 to Robert E. Rich, as assignee of Holton W. Diamond and Eugene L. Bowell, the joint inventors. Rich assigned the patent and his rights for past infringement to the plaintiff, Rich Products Corporation.

Subsequent thereto the appellee commenced this action in the Western District of New York, alleging that the patent was being infringed, and demanding an accounting and injunction. The appellants denied the infringement, and affirmatively claimed that the patent was invalid because (1) it had been anticipated by (a) a patent granted in a foreign country more than one year prior to the date of the application for the United States patent (35 U. S. C. § 102(b) (1964 ed.)), and (b) a description in a printed publication in this country also prior to the application (35 U. S. C. § 102(a) (1964 ed.)), and (2) that the subject matter as a whole was obvious at the time of the invention (35 U. S. C. § 103 (1964 ed.)).

The patent describes various liquid emulsions which, when whipped, change in appearance and characteristics into a firm non-pourable product suitable for use as a salad or dessert topping. The appellee, Rich Products Corporation, has for twenty years been in the business of manufacturing and distributing whippable emulsions, and since the spring of 1956 has manufactured and distributed the product described in the patent in suit.

The record discloses that the desirable qualities of a commercial grade, whippable emulsion topping are: a con-

sistently high yield of whipped topping from the liquid emulsion; a consistently stable topping which will not shrink, weep or collapse, or otherwise become deformed prior to consumption; and the attribute of remaining unspoiled even when stored for a relatively lengthy period. The patent in suit produces a product which possesses all of those qualities.

The whippable emulsions specified in the patent have four essential ingredients: water, an edible natural glyceride fat, a substituted cellulose of a special type, and at least one of a specified group of emulsifiers. In addition, sweeteners or flavoring substances may be, and normally are, added. These ingredients are then blended together as set forth in the patent to produce the cream product.

With regard to these components, the edible fat may be derived from animal or vegetable sources and the substituted cellulose is defined in the patent as one in "which at least some of the hydrogen molecules have been substituted with alkyl groups containing not more than two carbon atoms and at least part of such groups being methyl." The emulsifiers are described with particularity in the patent, but for purposes of this litigation they have been identified by their trade names: Spans, Tweens, Myverol, Vrest and Myrj.

The patent in suit sets out five claims, four of which are at issue here, and each of the four teaches the use of the four essential ingredients. Claim One, the generic claim, recites the use of water, fat, a substituted cellulose and any one or more of the four named emulsifying agents. Claims Two, Three and Four each includes water, fat, a substituted cellulose and an emulsifier (Spans in Claim Two, Tweens in Claim Three, and Myverol or Vrest in Claim Four).[1] The function of the emulsifiers is to give the resulting product its characteristic of being particularly whippable and consistent. The substituted cellulose, which

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[1] Claim Five is not in dispute here because it specifies the use of Myrj which has been declared by the Food and Drug Administration not suitable for human consumption.

replaces protein, contributes the quality of keeping well in storage for a substantial period.

The trial court decided that the patent was valid and that it had been infringed by the appellants. It is from that decision that this appeal is taken. We affirm.

The questions before us are (1) whether, applying the usual standards of appellate review, there is sufficient in the record to support the findings of fact upon which the trial court based its conclusions of absence of anticipation in prior art and lack of obviousness at the time of invention, and (2) whether, applying the standard of full review, the facts found warranted those conclusions and the ultimate determination that the patent was valid. *Crest Specialty* v. *Trager*, 341 U. S. 912 (1951), reversing 184 F. 2d 577 (7th Cir. 1950); *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147 (1950); *Mahn* v. *Harwood*, 112 U. S. 354, 358 (1884); *Gross* v. *JFD Manuf. Co., Inc.*, 314 F. 2d 196, at 198-99 (2d Cir.), cert. den. 374 U. S. 832 (1963); *Tatko Bros. Slate Co.* v. *Hannon*, 270 F. 2d 571, at 572 (2d Cir.), cert. den. 361 U. S. 915 (1959); Note, 29 U. Chi. L. Rev. 185 (1961).

### Anticipation

The claim of anticipation is based largely upon two patents issued in Great Britain which described a product somewhat similar to that set forth in the present patent and upon a chemical study which is referred to as the "Pratt article." There is also a claim that one of the patentees improperly induced the Patent Office to grant the patent.

#### *The British Patents*

The two British patents which the appellants cite as having anticipated the patent in suit are No. 555,361, issued in 1942, and No. 646,484, issued in 1950, a claimed improvement[2] on the 1942 patent. The central issue of the case,

[2] Patent No. 646,484 varies in that it specifies different oils which may be used in the preparation of the basic fat blend.

as pursued by the parties at the trial and in their briefs in this court, is a fairly narrow one and principally concerns the use of the term "glyceryl monostearate." The special significance of that substance in this litigation arises from its inclusion as an alternate ingredient in the British patent, and the appellants' contention that it is chemically and functionally the equivalent of the emulsifier, Myverol, specified in Claim Four of the patent in suit. The first British patent states that it "relates to the manufacture of a cream substitute and has as its object the manufacture of a cream substitute which will not suffer the souring or putrefying changes that are common to natural cream or to artificial creams . . ." The patent specification sets forth a formula which involves the use of two emulsifying agents, referred to as "A" and "B," both of which must be used. The other principal ingredient is a basic fat blend.[3] The total process for manufacturing the cream substitute, as revealed in the British patent, involves the mixing of all of these ingredients, as well as desired sweeteners, in a specified manner.

In the British process glyceryl monostearate is not *the* emulsifying agent, though by nature it is an emulsifier. Its principal function under both British patents is to

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[3] Emulsifying agent "A" is described therein as "consisting of a harmless chloride, a harmless salt of a tribasic acid and an edible vegetable gum preferably a marine vegetable gum such as an alginate." Agent "B" is described as "comprising a [substituted] cellulose derivative." The "cellulose derivative" of agent "B" is said in the patent "to cover cellulose having a hydrogen atom replaced by a hydrocarbon radical—e.g., alkyl or aryl—and to cover mixed alkyl ethers of cellulose." The patent also sets forth a "basic fat blend consisting of a mixture of a hardened vegetable oil of the leguminosae group, such as arachis oil, processed butter fat and a hardened oil of the palmae group, such as coconut oil [or, if using Patent #646,484, a basic fat blend consisting practically entirely of hardened oil of the palmae group] . . ." "Glycerine and, if desired, additional water may be mixed with the two suspensions [the aqueous suspensions of agent "A" and agent "B"] forming the aqueous gum base."

serve as an alternate fat-soluble vehicle for the coloring constituent, which the patent teaches "is preferably incorporated." The patents provide for an alternate formula for the basic fat blend which includes glyceryl monostearate to be used together with lecithin, both in very small relative portions. The emulsifier, however, in both British patents, is the function performed by agents "A" and "B." The patent in suit contains nothing comparable to agent "A," and its named emulsifiers are used in place of "A."

It appears from the record, and the district court so found,[4] after hearing much evidence on the point, that the glyceryl monostearate specified in the British patent is not the same substance that is referred to in the patent in suit. In its pure form glyceryl monostearate apparently exists only as a curiosity of the laboratory. However, various commercial forms of the composition are commonly available. The court found that the glyceryl monostearate mentioned in the British patent was comparable to a commercial variety known as "Aldo 33," and that Claim Four of the patent in suit actually describes a substance commercially marketed under the name Myverol 18-85. There was abundant evidence, largely the testimony of expert witnesses, to support the critical finding that Aldo 33 and Myverol

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[4] The district court found: " . . . Neither of these specified emulsifying agents of the British patent was comparable to any of the four classes of emulsifying agents specified in the patent in suit. There is no ingredient in the patent in suit comparable to emulsifying agent "A". . . . The glycerol monostearate of the British patent is comparable as an emulsifying agent to commercially available glycerol monostearate such as Aldo 33. The difference in function of these emulsifiers was shown in Diamond's affidavit submitted to the Patent Office. It was also shown at the trial. The experiment was repeated during the progress of the trial and the result shown at the trial. The glycerol monostearate of the British patent was not the same as Myverol 18-85 of the patent in suit. It is stated in the patent in suit that Myverol is purified by distillation under high vacuum. Such a process was not available until the early 1950's, whereas the British patent was published in August, 1943."

18-85 were substantially different both chemically and functionally. There was included in this evidence, testimony concerning two experiments, which were conducted by appellee's expert at the time of the trial, one using Aldo 33 and the other using Myverol 18-85 in the formula of the patent in suit. The resulting products differed significantly, and the one employing Myverol 18-85 exhibited the superiority in consistency and stability which the patent in suit claims.

The appellants make much of their assertion that glyceryl monostearate appears in both the British patents and in the patent in suit and that both Aldo 33 and Myverol may be encompassed within the general generic definition of glyceryl monstearate, but they did not prove that there was no chemical difference between them, nor did they persuasively refute the fact that the functions of these commercial versions in the respective patents were quite different and that the act of substituting Aldo 33 for Myverol in the formula of the patent in suit produced a distinctly inferior result.

The patent in suit does far more than merely restate the teaching of the British patent in some slightly variant manner. It is more than another method of doing the same thing. The British patent does "not bear within . . . [its] four corners adequate direction for the practice of the patent" in suit, *Dewey & Almy Chemical Co.* v. *Mimex Co.*, 124 F. 2d 986, 989 (2d Cir. 1942), and is, therefore, not an anticipation.

*The Pratt Article*

The discussion by C. F. Pratt, entitled "Certain Partial Ester Emulsifier Levels in Food," which appeared in Volume VI, No. 11, *Food Technology* 425-30 (1952), dealt with the uses of four groups of emulsifiers in a wide variety of applications and safe levels for such uses. While it mentions that emulsifiers are of practical use in the making of popular cream whips, it does not say which, if any,

would produce a result comparable to that achieved by the patent in suit, nor does it suggest any formula for such use; nor does it suggest how such a result could be achieved through the use of a particular emulsifier together with the teaching of the British patents.

A prior printed publication in order to defeat a patent "must exhibit a substantial representation of the patented invention. It must be in such full, clear and exact terms as to enable one skilled in the art to practice the patented improvement without the exercise of inventive skill of his own and without assistance from the patent claimed to have been anticipated." 1 Deller's Walker on Patents § 60, at 277-78 (2d ed. 1964); *Seymour* v. *Osborne*, 78 U. S. 516, at 554-55 (1871); *Eames* v. *Andrews*, 122 U. S. 40, at 64-66 (1886); *Linde Air Products Co.* v. *Morse Dry Dock & Repair Co.*, 246 Fed. 834, 839 (2d Cir. 1917); *Wisconsin Alumni Research Foundation* v. *George A. Breon & Co., Inc.*, 85 F. 2d 166 (8th Cir.), cert. den. 299 U. S. 598 (1936). The Pratt article completely fails even to suggest any of the details necessary for the practical application of the invention.

*Misrepresentations to the Patent Office*

The appellants also assert that one of the inventors, Diamond, made improper representations to the Patent Office Examiner while the application for the patent was being prosecuted. In effect, they say that Diamond represented to the Examiner that the glyceryl monostearate of the British patents was not an anticipation because the term as used in those patents referred to the laboratory or non-commercial glyceryl monostearate, which was a monoester, whose only fatty acid radicals were of stearic acid, rather than to commercial glyceryl monostearate, all forms of which contain radicals of fatty acids in addition to stearic.

Appellants argue that Diamond originally believed this himself and, through oral testimony and written affidavits,

persuaded the Examiner that the British patents meant the single partial fatty acid esters of glycerine and were thus distinguishable from the patent for which he was applying; that he later found it was not true, and that he amended Example III of his patent to correct his misimpression. At the hearing before the examiner Diamond had also filed certain affidavits detailing experiments which demonstrated the different results which occurred when Aldo 33 was substituted for Myverol 18-85 in the formula specified in his patent. Both of these substances were commercial glyceryl monostearates, and each contained fatty acid radicals in addition to stearic.

The plaintiff-appellee offered persuasive evidence on this issue to prove there was no misrepresentation. The trial court found,

> "Diamond's affidavit submitted to the Patent Office did not misrepresent the state of the art when the application for patent was pending. The representations made to the Patent Office were true. The examiner was not improperly induced to allow the claims of the patent in suit."

We are of the opinion that the trial court's findings of the basic or primary facts relating to the issue of anticipation in prior art, as well as the claim of misrepresentations to the Patent Office, are fully supported by the evidence and are not clearly erroneous. Moreover, our review of the conclusion which the court drew from those primary facts satisfies us that the patent was not invalid because of anticipation in prior art. *Gross* v. *JFD Manuf. Co., Inc., supra,* at 198-99; *Tatko Bros. Slate Co.* v. *Hannon, supra,* at 572.

*Obviousness of Subject Matter*

On the facts before us, which we have found to be clearly supported by the evidence, we conclude that the subject matter as a whole was not, at the time of the invention, obvious to a person having skill in the art.

The patent taught a formula which allowed the successful production, for the first time, of a substitute cream product which embodied not only characteristics of long life, but also of consistency, volume and whippability, which were commercially desirable. In other words, it furnished a satisfactory amount of whipped topping for the quantity of emulsion used; and the topping produced, unlike others, did not collapse but was unusually stable and held its whipped form. This advance was the result of something more than simply the skill and knowledge possessed by one familiar with the art. See, e.g., *Lyon* v. *Bausch & Lomb Optical Co.*, 224 F. 2d 530, at 534-36 (2d Cir.), cert. den. 350 U. S. 911 (1955); *Reiner* v. *I. Leon Co.*, 285 F. 2d 501, at 503-4 (2d Cir. 1960), cert. den. 366 U. S. 929 (1961). This is confirmed by the fact that the need for the invention was demonstrated by the substantial and immediate success which the product enjoyed. Furthermore, despite independent efforts to develop such a product, appellants never succeeded in doing so; and it was not until they obtained a copy of the patent in suit that they began to market such a product. While commercial success cannot alone support "patentability," it can reenforce such a conclusion. *Goodyear Tire & Rubber Co., Inc.* v. *Ray-O-Vac Co.*, 321 U. S. 275, at 279 (1944); *Reiner* v. *I. Leon Co., supra*, at 503; *Technical Tape Corp.* v. *Minnesota Mining & Mfg. Co.*, 247 F. 2d 343, 347-48 (2d Cir.), cert. den. 355 U. S. 952 (1957).

The appellants, as defendants below, presented no evidence sufficiently persuasive to cast doubt on the correctness of Judge Burke's findings and the conclusions reached. There is a statutory presumption that a patent is valid, and it is the challengers, carrying the burden of proof, who must overcome it. This they failed to do. 35 U. S. C. § 282 (1964 ed.); *Radio Corp. of America* v. *Radio Eng. Laboratories, Inc.*, 293 U. S. 1, 7-8 (1934). The presumption is strengthened, in a case such as this, where the same questions were raised in prosecuting the patent in the Patent Office and there successfully met. *Lyon* v. *Bausch & Lomb*

*Optical Co.*, 119 F. Supp. 43, at 45 (S. D. N. Y. 1953), aff'd 224 F. 2d 530 (2d Cir.), cert. den. 350 U. S. 911 (1955); *Cutler Mail Chute Co.* v. *Capitol Mail Chute Corp.*, 118 F. 2d 63, at 64 (2d Cir.), cert. den. 313 U. S. 580 (1941); *Nasco Inc.* v. *Vision-Wrap, Inc.*, 352 F. 2d 905, at 908 (7th Cir. 1965).

Therefore, as the invention was neither anticipated by prior art nor obvious to one having ordinary skill in the art, we affirm the district court's conclusion that the patent was valid. There remains only the issue of infringement.

INFRINGEMENT

The appellants deny that the whipped cream product which they have been manufacturing and marketing infringes the appellee's patent. They assert that the substituted cellulose, hydroxypropyl methyl, which they use, differs from the specification of the patent which calls for the use of a "cellulose substituted with alkyl groups comprising not more than two carbon atoms and at least a part of such groups being methyl." Even though hydroxypropyl is not an alkyl group, the plain language of the claim does not require that the substitution be solely or exclusively alkyl groups; and hydroxypropyl methyl cellulose is a cellulose substituted with alkyl groups. Appellants' substituted cellulose is comprised of 5/6 methyl and 1/6 hydroxypropyl.

While the use of this ingredient by the appellants makes a slight technical variation from the language of Claim Four, there was sufficient support in the record for the trial court's conclusion that "the substituted cellulose used by the defendants is the chemical and functional equivalent of methyl cellulose and methyl ethyl cellulose, which are specifically described in the patent in suit."

Under the "doctrine of equivalents," which applies to chemical substitutes, *Graver Tank & Mfg Co.* v. *Linde Air Products Co.*, 339 U. S. 605, at 607-09 (1950), the use by the appellants in this case of a substance which "performs

substantially the same function in substantially the same way to obtain the same result" as the patented process, constitutes an infringement. *Sanitary Refrigerator Co.* v. *Winters*, 280 U. S. 30, at 42 (1929). What is prohibited is not merely outright duplication, but also that more subtle duplication which is accomplished by a change in one of the non-critical aspects of the patent's teachings. If that were permitted, form would be elevated above substance, and literalness would triumph over fairness and good sense.

The judgment of the district court is affirmed.

## JUDGMENT

**Entered February 15, 1966**

BEFORE

HON. LEONARD P. MOORE
HON. J. JOSEPH SMITH
HON. ROBERT P. ANDERSON

This cause came on to be heard on the transcript of record from the United States District Court for the Western District of New York, and was argued by counsel.

ON CONSIDERATION WHEREOF, it is now hereby ordered, adjudged, and decreed that the decree of said District Court be and it hereby is affirmed with costs to the appellee.

## DECISIONS DENYING PETITION FOR REHEARING

**Filed April 11, 1966**

*Petition for Rehearing*

We have considered the case in the light of (1) *Graham* v. *John Deere Co.*, 383 U. S. , 34 U. S. L. W. 4119 (1966) and (2) *United States* v. *Adams*, 383 U. S. , 34 U. S. L. W. 4132 (1966), and are of the opinion that they do not require a change of holding. Petition for rehearing is denied.

L. P. M.
J. J. S.
R. P. A.
U. S. C. JJ.

*Petition for Rehearing In Banc*

No active circuit judge having requested that the case be reheard in banc, the petition is denied.

sgd/ J. EDWARD LOMBARD
Chief Judge

## FINDINGS AND CONCLUSIONS OF THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF NEW YORK

**Filed June 30, 1965**

*Findings of Fact.*

1. Plaintiff is the owner of all right, title, and interest in the patent in suit, United States Letters Patent No. 2,868,653, issued January 13, 1959, having obtained title by assignment from the joint inventors, Holton W. Diamond and Eugene L. Powell.

2. The patent covers liquid emulsions which change, when whipped, in appearance and characteristics into a firm non-pourable product suitable as a salad and dessert topping.

3. The whippable emulsions of the patent have at least four essential ingredients: (a) water, (b) an edible fat, (c) a substituted cellulose of a special type, (d) at least one of a specified group of emulsifiers. Sweeteners or flavoring substances may be, and are, normally added.

4. The edible fat may be derived from animal or vegetable sources. The substituted cellulose used is one which has been modified to replace some of the hydrogen atoms in the chemical composition with methyl groups. The emulsifiers used are set forth in their chemical terminology in the specifications and claims. These emulsifiers have been identified in the patent and at the trial by their trade names, Spans, Tweens, Myverols and Myrj.

5. Claims 1 through 4 each recites the use of these four essential ingredients. Claim 1 recites the use of water, fat, a substituted cellulose and any one or more of the four types of specified emulsifiers. Claims 2, 3 and 4 each include water, fat, a substituted cellulose and an emulsifier. The emulsifier in Claim 2 is Spans, in Claim 3 Tweens, and in Claim 4 Myverol.

6. The desirable qualities of a whipped topping are: reliable whipping in a relatively short time; a consistently high yield of whipped topping as compared to a liquid emulsion; a consistently stable topping which will not shrink, weep, or collapse; a relatively long storage period without spoiling. The proof establishes that the whipped topping covered by the patent has all of these desirable qualities. Because the emulsion covered by the patent does not contain protein, it has a long storage life without becoming rancid or sour.

7. The prior patents and publications relied on by the defendants at the trial were substantially the same in disclosure as those which were before the Patent Office during the prosecution of the patent application. During the prosecution of the application in the Patent Office there was before the Patent Office the question whether a specific emulsifier (glyceryl monostearate), which was specified as an optional ingredient in one of the prior art patents (British 555,361), was the same or the equivalent of one of the emulsifiers covered by the patent in suit. This is the same question on which defendants base their prior art defense. The Examiner was convinced by evidence that the glyceryl monostearate in the prior art patents was different from Myverol in the patent in suit, which is defined as "refined complex mixtures resulting from metathetical reaction of a complete glyceride fat with an excess of glycerol." The evidence that convinced the Examiner was experiments conducted by Diamond, where two emulsions were made in exactly the same manner and having exactly the same ingredients, except that in one emulsion a commercial grade glyceryl monostearate (Aldo 33) was used. The results of these experiments were submitted to the Examiner in an affidavit of Diamond, accompanied by pictures of the resulting products and literature describing the respective emulsifying agents in detail. After this submission, the Patent Office granted the patent. At the trial, plaintiff's expert testified that he observed and assisted in conducting experiments identical to those that were con-

ducted as the basis of Diamond's affidavit that was filed in the Patent Office. The results of his own experiments were explained by plaintiff's expert at the trial. The results, including photographs and the resulting products themselves, show that the functional differences between Aldo 33 and Myverol 18-85 are substantial. The proof establishes that there are marked chemical differences between Aldo 33 and Myverol 18-85 and that these substances are substantially different emulsifying agents from a functional standpoint.

8. At the trial, defendants produced testimony regarding nine ex parte experiments made for the express purpose of the trial, to show that Diamond's statements in his affidavit submitted to the Examiner were incorrect, and that glyceryl monostearate of British Patent No. 555,361 was the same as Myverol 18-85 of the patent in suit. Of the nine experiments seven were entirely uncorroborated. The other two were uncorroborated as to whipping after overnight storage. None of the nine experiments used Myverol 18-85. No photographs showing the results of the experiments were produced. These nine experiments were a selected nine out of thirty-nine experiments conducted for the same purpose. No evidence was produced as to the results of the other thirty experiments. Of the nine experiments, only three dealt with glyceryl monostearate (Aldo 33) referred to by Diamond in his affidavit submitted to the Examiner. The other six used other products identified as glyceryl monostearate produced by another manufacturer. This evidence produced by the defendants, to show that Diamond's statements in his affidavit submitted to the Examiner were incorrect, was not convincing.

9. Defendants rely heavily on British Patent No. 555,361, which was extensively considered by the Patent Office in the prosecution of the application for the patent in suit. The British patent teaches the preparation of a cream substitute prepared in two steps. First, an aqueous gum base is prepared by mixing an aqueous suspension of an

emulsifying agent "A", which consists of a harmless chloride, a harmless salt of tri-basic acid, and an edible vegetable gum such as sodium alginate with an emulsifying agent "B" comprising a cellulose derivative; secondly, the aqueous gum base is blended with a fat selected from a specified group of oils, and water is added to complete the composition. The basic composition of the cream substitute of the British patent consists of water, fat and emulsifying agents "A" and "B". The British patent teaches that emulsifying agents "A" and "B" must be used in each instance. Neither of these specified emulsifying agents of the British patent was comparable to any of the four classes of emulsifying agents specified in the patent in suit. There is no ingredient in the patent in suit comparable to emulsifying agent "A". The British patent also states that the compound glycerol monostearate may be used as an optional ingredient, without showing its function as an emulsifier or otherwise. The glycerol monostearate, which is stated to be an optional ingredient in the British patent, is not the same emulsifier that is described in the patent in suit, *viz.*, "refined complex mixtures resulting from the metathetical reaction of complete glyceride fat with an excess of glycerol." The glycerol monostearate of the British patent is comparable as an emulsifying agent to commercially available glycerol monostearate such as Aldo 33. The difference in function of these emulsifiers was shown in Diamond's affidavit submitted to the Patent Office. It was also shown at the trial. The experiment was repeated during the progress of the trial and the result shown at the trial. The glycerol monostearate of the British patent was not the same as Myverol 18-85 of the patent in suit. It is stated in the patent in suit that Myverol is purified by distillation under high vacuum. Such a process was not available until the early 1950's, whereas the British patent was published in August, 1943.

10. Defendants also rely on British Patent 646,484. This patent differed from British 555,361 only in the type of fats specified. This prior art reference adds nothing to the

teaching of British Patent 555,361. British Patent 646,484 was also before the Patent Office during the prosecution of the application for the patent in suit.

11. Defendants also rely on an article, "Certain Partial Ester Emulsifier Levels in Food," by C. F. Pratt. This article deals with the safe levels of use of four classes of emulsifiers in a wide variety of applications. Although it discloses the uses of these emulsifiers in many products, it does not mention a whipped topping containing a substitute cellulose.

12. The prior art citations referred to above and relied on by the defendants do not teach a method to produce the product covered by the claims of the patent in suit. The disclosures covered by the patent in suit were of an inventive and patentable character and were not anticipated by any prior patents or publications.

13. Diamond's affidavit submitted to the Patent Office did not misrepresent the state of the art when the application for the patent was pending. The representations made to the Patent Office were true. The Examiner was not improperly induced to allow the claims of the patent in suit.

14. The patent in suit defines a new and useful product which represents a material advance over the prior art. This is shown in part by the defendants' adoption as soon as the disclosures of the patent were available. The defendants secured a copy of the patent in June, 1959.

15. The whippable emulsions manufactured and sold by both plaintiff and defendants before they had knowledge of the disclosures of the patent, were comprised of water, fat, protein-containing material and an emulsifier. These products which contained protein tended to develop undesirable flavors due to rancidity or souring, after a short time and did not give a consistently high yield, comparable to the emulsions of the patent.

16. Subsequent to the disclosures of the patent, both plaintiff and defendants commenced to make and sell an emulsion without protein content. The proof establishes that the defendants had, prior to the disclosures of the patent, attempted without success to develop a whippable emulsion using substituted celluloses. These unsuccessful attempts were performed by the defendant, Frank S. Mitchell. He had had a number of years of practical experience in this field. The advantages of the patent disclosures in providing a non-protein type of whippable emulsion with desirable stability, short whipping time, consistently high yield, and long storage life, were readily recognized by the defendants. They promptly started to use the patent disclosures in their commercial products.

17. In answers to plantiff's interrogatories sworn to by the defendant, Frank S. Mitchell, infringement of Claim 1 was admitted. In these interrogatories plaintiff asked the defendants, in language taken from Claim 1, whether their ready-to-use topping (Mitchell's Scotch Topping), as manufactured by or for defendants at any time during the six-year period preceding this suit, contained each of the four essential ingredients as set forth in Claim 1. The defendants answered in the affirmative. In response to further interrogatories, defendants conceded that they included in their Mitchell's Scotch Topping one or more of the Claim 1 emulsifiers, except Myrj, and that the proportions of the four essential ingredients in this product came within the combinations covered by Claim 1.

18. Defendants were also asked in interrogatories the same questions regarding manufacture of their whipped topping base, which is diluted by the consumer before being whipped (Mitchell's Whip Filling Base). Defendants' answers established infringement of Claim 1 by this product.

19. Since March, 1960, defendants have produced and sold ready-to-use whippable emulsions which infringe Claims 2 and 3, and whippable emulsion bases which infringe Claims 2, 3 and 4.

20. In the face of answers to interrogatories referred to above, the defendants at the trial denied infringement, the sole basis for such denial being their contention that the emulsifier used by the defendants, hydroxy-propyl methyl cellulose, does not come within the definition of a substituted cellulose as used in the patent, *viz.*, "a cellulose substituted with alkyl groups comprising not more than two carbon atoms and at least part of such groups being methyl." The substituted cellulose used by defendants is covered by this language. Moreover, the substituted cellulose used by defendants is the chemical and functional equivalent of methyl cellulose and methyl ethyl cellulose which are specifically described in the patent in suit.

21. Hydroxypropyl methyl cellulose is a cellulose substituted with both methyl groups and hydroxypropyl groups, with a ratio of substitution being about six methyl substitutions to every one hydroxypropyl substitution. Hydroxypropyl methyl cellulose is chemically a variant of methyl cellulose having a minor substitution of hydroxypropyl groups in addition to methyl groups and falls within the language of the claim "a cellulose substituted with alkyl groups comprising not more than two carbon atoms and at least part of such groups being methyl." The overwhelming proportion of such substitutions in this cellulose are methyl groups. Only a minor proportion are hydroxypropyl groups.

22. Defendants' expert at the trial testified that the language of the claim limits the type of substituted cellulose to either a cellulose substituted with methyl or ethyl or methyl-ethyl groups and no other. This interpretation of the claim is rejected as being contrary to ordinary English usage. The language of the claim means that some of the substitutions must be methyl. It does not mean that there may be no other substitutions. Hydroxypropyl methyl cellulose which contains predominately methyl substitutions is included within the language of the claim, even though it also includes a minor substitution of hydroxypropyl constitutions.

23. Hydroxypropyl methyl cellulose is the chemical and functional equivalent of methyl cellulose.

24. The commercial products of the defendants which they now produce and which they did produce at and prior to December, 1962, when Mitchell signed the answers to the interrogatories referred to above, infringe the patent in suit.

25. The evidence establishes that the defendant, Frank S. Mitchell, was the chief executive officer of Mitchell Foods, Inc. He was in active and direct control of the operations of Mitchell Foods, Inc. He is therefore personally responsible for the infringement.

## Conclusions of Law

1. The patent in suit, United States Patent No. 2,868,653, issued January 13, 1959, including Claims 1 through 4, is a valid patent.

2. The Patent Office Examiner was not improperly induced to allow the claims of the patent.

3. The products which the defendants have manufactured and sold in their commercial operations after the issuance of the patent in suit and prior to and after the filing of this suit, without permission of the plaintiff, incorporated the invention of the patent and infringed some or all of Claims 1 through 4.

4. The defendant, Frank S. Mitchell, is personally liable jointly with the defendant, Mitchell Foods, Inc. He was the person actively controlling and directing the operations of Mitchell Foods, Inc., including the acts of infringement.

5. Plaintiff is entitled to an injunction restraining the defendants from further infringing the patent and to an accounting for damages to compensate for the infringement, with interest and costs.

Settle decree on 3 days' notice.

HAROLD P. BURKE,
*U. S. District Judge.*